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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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SEP 14 2010

OFFICE OF PETITIONS

In re Application of	:	
Rhee et al.	:	DECISION ON APPLICATION
Application No. 10/596,412	:	FOR PATENT TERM ADJUSTMENT
Filed: June 13, 2006	:	
Attorney Docket No. TRIUS.002NP	:	

This is a decision on the request filed January 12, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(b) requesting the initial determination of patent term adjustment be corrected from one hundred thirty-eight (138) days to eight hundred sixty-four (864) days.

The petition is **granted to the extent indicated herein**.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is 254 days. A copy of the updated PALM screen showing the correct determination is enclosed.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) on December 24, 2009, advising Applicants a patent term adjustment to date of 138 days. The 138-day patent term adjustment determination was the result of:

1. A 206-day increase in patent term adjustment under 37 C.F.R. § 1.703(a)(1),
2. A 56-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8), and
3. A 12-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b).

Applicants request the patent term adjustment be corrected to 864 days. Applicants assert the patent term adjustment should:

1. Include a 864-day, not 206-day, increase in patent term adjustment under 37 C.F.R. § 1.703(a)(1),
2. *Not* include a 56-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8),
3. *Not* include a 12-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b).

Applicants timely filed this application for patent term adjustment prior to payment of the issue fee.

37 C.F.R. § 1.703(a)(1)

Pursuant to 37 C.F.R. § 1.703(a)(1), the period of adjustment of patent term due to examination delay includes:

The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

The application was filed June 13, 2006. The Office issued an action under 35 U.S.C. § 132 on March 6, 2008, which is 14 months and 206 days after Applicants fulfilled the requirements of 35 U.S.C. § 371. Based on the prior facts, the Office determined the period of adjustment under 37 C.F.R. § 1.703(a)(1) is 206 days.

Applicants state the period of adjustment under 37 C.F.R. § 1.703(a)(1) is greater than 206 days because all the Office actions under 35 U.S.C. § 132 issued in this case, including the March 6, 2008 Office action, were vacated.

Group Directors in Technology Centers have the authority to vacate Office actions. Examiners and Quality Assurance Specialists do not have the authority to vacate Office actions. A Group Director only vacated one Office action in this case. Specifically, on October 8, 2009, the Office issued a decision signed by a Group Director vacating the Office action issued August 13, 2009.

The Interview Summary Form issued December 7, 2009, states the March 6, 2008 Office action "is hereby vacated." However, the form is signed by a Quality Assurance Specialist ("QAS"), not a Group Director. As previously stated, a QAS lacks the authority to vacate an Office action. Therefore, the March 6, 2008 Office action was not vacated.

Since the March 6, 2008 Office action was not vacated, the proper period of adjustment under 37 C.F.R. § 1.703(a)(1) is 206 days.

37 C.F.R. § 1.704(c)(8)

Applicants contend the Office's entry of a 56-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8), as a result of the information disclosure statement ("IDS") filed July 6, 2009, was improper.

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days,

if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The Office issued a non-final Office action on February 11, 2009. Applicants filed an amendment on May 11, 2009. Applicants filed an information disclosure statement (“IDS”) without a statement under 37 C.F.R. § 1.704(d) on July 6, 2009, which is 56 days after Applicants filed the May 11, 2009 reply. Based on the prior facts, the Office entered a 56-day reduction under 37 C.F.R. § 1.704(c)(8).

Applicants assert the IDS was not filed after a “reply” because, as a result of the Office vacating the February 11, 2009 Office action, the amendment cannot be considered a “reply” to the February 11, 2009 Office action.

The Interview Summary Form issued December 7, 2009, states the February 11, 2009 Office action “is hereby vacated.” However, the form is signed by a Quality Assurance Specialist (“QAS”), not a Group Director. A QAS lacks the authority to vacate an Office action. Therefore, the February 11, 2009 Office action was not vacated.

37 C.F.R. § 1.704(b)

37 C.F.R. § 1.704(b) provides for a reduction in patent term adjustment when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request.

The Office mailed a non-final Office action on January 29, 2009. The Office mailed a new non-final Office action on February 11, 2009. Applicants filed a reply on May 11, 2009. The Office entered a 12-day reduction under 37 C.F.R. § 1.704(b) because the May 11, 2009 reply was filed three months and 12 days after the Office issued the January 29, 2009 Office action.

Applicants assert the entry of the 12-day reduction was improper because the Office action mailed January 29, 2009, was vacated. Although the Office does not agree the January 29, 2009 Office action was “vacated,” the Office does agree entry of the 12-day reduction was improper.

The February 11, 2009 Office action restarted the time period for reply. As a result, the three-month period of time under 37 C.F.R. § 1.704(b) began February 11, 2009. The May 11, 2009 reply was filed within three months of the Office issuing the February 11, 2009 Office action. Therefore, a reduction under 37 C.F.R. § 1.704(b) is unwarranted.

37 C.F.R. § 1.703(a)(2)

A review of the record indicates the Office should have entered a 104-day increase in patent term adjustment under 37 C.F.R. § 1.703(a)(2).

Pursuant to 37 C.F.R. § 1.703(a)(2), the period of adjustment of patent term due to examination delay includes:

The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

Applicants filed a reply to an Office action on May 11, 2009.

Although the Office issued an Office action on August 13, 2009, a decision vacating the Office action was issued on October 8, 2009. The decision was signed by Remy Yucel, a Group Director in Technology Center 1600.

The Office issued a Notice of Allowance on December 24, 2009, which is four months and 104 days after the date Applicants filed the May 11, 2009 reply.

In view of the prior discussion, a 104-day increase in patent term adjustment is warranted under 37 C.F.R. § 1.703(a)(2).

Conclusion

The patent term adjustment at the time of mailing of the notice of allowance is 254 days, which is the sum of 206 days of delay under 37 C.F.R. § 1.703(a)(1) and 104 days of delay under 37 C.F.R. § 1.703(a)(2) reduced by 56 days of delay under 37 C.F.R. § 1.704(c)(8).

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

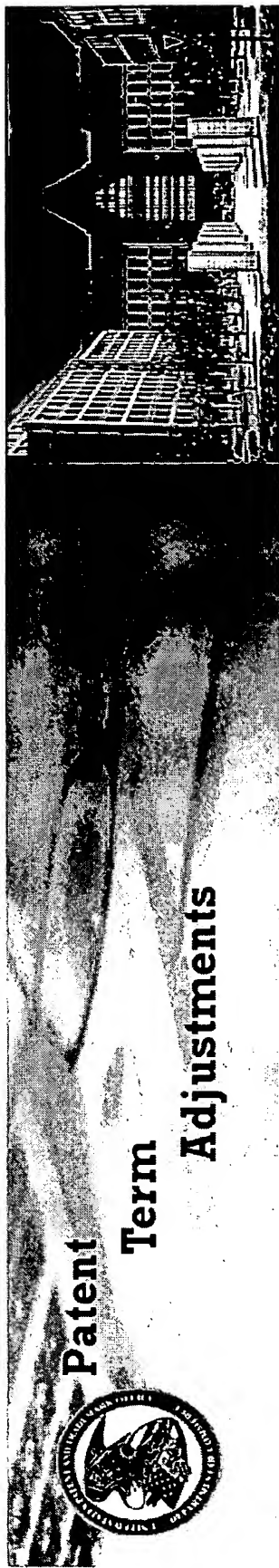
The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen



PTA/PTE Information

Application Number*: Search Explanation of PTA Calculation Explanation of PTE Calculation

PTA Calculations for Application:

Application Filing Date	06/13/2006	OverLapping Days Between (A and B) or (A and C)	0
Issue Date of Patent		Non-Overlapping USPTO Delays:	206
A Delays	206	PTO Manual Adjustment	116
B Delays	0	Applicant Delay (APPL)	68
C Delays	0	Total PTA (days)	254

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
119	09/13/2010		P028	Adjustment of PTA Calculation by PTO	116		0
97	12/24/2009		MN/=.	Mail Notice of Allowance			0
96	12/18/2009		IREV	Issue Revision Completed			0
95	12/18/2009		DVER	Document Verification			0
94	12/18/2009		N/=.	Notice of Allowance Data Verification Completed			0

93	12/18/2009	CNTA	Notice of Allowability	0
92	12/07/2009	EML_NTR	Email Notification	0
91	12/07/2009	EML_NTR	Email Notification	0
90	12/07/2009	MEXIN	Mail Examiner Interview Summary (PTOL - 413)	0
89	12/07/2009	MM327	Mail Miscellaneous Communication to Applicant	0
88	12/02/2009	M327	Miscellaneous Communication to Applicant - No Action Count	0
85	11/19/2009	EXIN	Examiner Interview Summary Record (PTOL - 413)	0
83	10/20/2009	MAPCA	Mail Appeals conf. Rej. withdrawn	0
84	10/19/2009	FWDX	Date Forwarded to Examiner	0
82	10/16/2009	APCA	Pre-Appeals Conference Decision - Rejection Withdrawn	0
79	10/14/2009	EML_NTR	Email Notification	0
78	10/08/2009	MPTGR	Mail-Petition Decision - Granted	0
77	10/07/2009	PTGR	Petition Decision - Granted	0
81	09/14/2009	AP.C	Request for Pre-Appeal Conference Filed	0
80	09/14/2009	N/AP	Notice of Appeal Filed	0
76	09/14/2009	PET.	Petition Entered	0
75	09/04/2009	EML_NTR	Email Notification	0
74	09/04/2009	MCTAV	Mail Advisory Action (PTOL - 303)	0
73	08/31/2009	CTAV	Advisory Action (PTOL-303)	0
72	08/28/2009	FWDX	Date Forwarded to Examiner	0
71	08/27/2009	A.NE	Amendment after Final Rejection	0
70	08/13/2009	ELC_RVW	Electronic Review	0
69	08/13/2009	EML_NTF	Email Notification	0
68	08/13/2009	MCTFR	Mail Final Rejection (PTOL - 326)	0
67	08/11/2009	CTFR	Final Rejection	0
87	05/11/2009	M844	Information Disclosure Statement (IDS) Filed	56
86	07/06/2009	M844	Information Disclosure Statement (IDS) Filed	61
64	07/06/2009	IDSC	Information Disclosure Statement considered	0
63	07/06/2009	WIDS	Information Disclosure Statement (IDS) Filed	0
62	06/24/2009	FWDX	Date Forwarded to Examiner	0
66	06/01/2009	IDSC	Information Disclosure Statement considered	0

65	06/01/2009	IDSC	Information Disclosure Statement considered	0
59	06/01/2009	WIDS	Information Disclosure Statement (IDS) Filed	0
58	06/01/2009	WIDS	Information Disclosure Statement (IDS) Filed	0
61	05/11/2009	04/29/2009 A...	Response after Non-Final Action	12
60	05/11/2009	XT/G	Request for Extension of Time - Granted	0
57	02/11/2009	MM327	Mail Miscellaneous Communication to Applicant	0
56	02/06/2009	M327	Miscellaneous Communication to Applicant - No Action Count	0
55	02/06/2009	RRESP	Restart Response of action	0
54	01/29/2009	ELC_RVW	Electronic Review	0
53	01/29/2009	EML_NTF	Email Notification	0
52	01/29/2009	MSRNF	Mail Supplemental Non-Final Action	0
51	01/23/2009	SRNF	Supplemental Non-Final Action	0
48	12/16/2008	EML_NTR	Email Notification	0
47	12/16/2008	MNRES	Mail Notice of Restarted Response Period	0
46	12/11/2008	NRES	Letter Restarting Period for Response (i.e. Letter re: References)	0
50	10/31/2008	IDSC	Information Disclosure Statement considered	0
49	10/31/2008	M844	Information Disclosure Statement (IDS) Filed	0
45	10/31/2008	WIDS	Information Disclosure Statement (IDS) Filed	0
43	09/23/2008	EML_NTR	Email Notification	0
42	09/23/2008	MEXIN	Mail Examiner Interview Summary (PTOL - 413)	0
44	09/15/2008	LET.	Miscellaneous Incoming Letter	0
41	09/11/2008	EXIN	Examiner Interview Summary Record (PTOL - 413)	0
40	08/04/2008	ELC_RVW	Electronic Review	0
39	08/04/2008	EML_NTR	Email Notification	0
38	08/04/2008	EML_NTF	Email Notification	0
37	08/04/2008	MW/AC	Mail Notice of Withdrawn Action	0
36	08/04/2008	MCTNF	Mail Non-Final Rejection	0
35	07/30/2008	EXIN	Examiner Interview Summary Record (PTOL - 413)	0
34	07/25/2008	EML_NTR	Email Notification	0

33	07/25/2008	PA..	Change in Power of Attorney (May Include Associate POA)	0
32	07/22/2008	C.AD	Correspondence Address Change	0
31	07/16/2008	CTNF	Non-Final Rejection	0
30	07/16/2008	FWDX	Date Forwarded to Examiner	0
29	07/16/2008	W/AC	Letter Withdrawing / Vacating Office Action	0
28	06/23/2008	MCTNF	Mail Non-Final Rejection	0
27	06/19/2008	CTNF	Non-Final Rejection	0
24	04/22/2008	FWDX	Date Forwarded to Examiner	0
23	03/19/2008	ELC.	Response to Election / Restriction Filed	0
22	03/06/2008	08/13/2007 MCTRS	Mail Restriction Requirement	206
21	02/28/2008	CTRS	Requirement for Restriction / Election	0
20	12/11/2007	DOCK	Case Docketed to Examiner in GAU	0
19	08/10/2007	A.PE	Preliminary Amendment	0
18	07/06/2007	TSSCOMP	IFW TSS Processing by Tech Center Complete	0
14	07/05/2007	PG- ISSUE	PG-Pub Issue Notification	0
11	04/18/2007	OIPE	Application Dispatched from OIPE	0
8	03/27/2007	M903	Notice of DO/EO Acceptance Mailed	0
9	03/26/2007	PGPC	Sent to Classification Contractor	0
26	08/31/2006	IDSC	Information Disclosure Statement considered	0
17	08/31/2006	M844	Information Disclosure Statement (IDS) Filed	0
13	08/31/2006	WIDS	Information Disclosure Statement (IDS) Filed	0
25	06/13/2006	IDSC	Information Disclosure Statement considered	0
16	06/13/2006	RQPR	Request for Foreign Priority (Priority Papers May Be Included)	0
15	06/13/2006	M844	Information Disclosure Statement (IDS) Filed	0
12	06/13/2006	WIDS	Information Disclosure Statement (IDS) Filed	0
10	06/13/2006	371COMP	371 Completion Date	0
2	06/13/2006	L194	Cleared by OIPE CSR	0
1	06/13/2006	IEXX	Initial Exam Team nn	0

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